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Paper No. 15
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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RA Brands, L.L.C.

v.

Pure Fishing, Inc.[1]

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Opposition No. 120,088
to application Serial No. 75/671,704
filed on March 31, 1999

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Randel S. Springer of Womble Carlyle Sandridge & Rice, PLLC for RA Brands, L.L.C.

Lance G. Johnson of Roylance, Abrams, Berdo & Goodman, L.L.P. for Pure Fishing, Inc.

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Before Seeherman, Walters and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

[1] The caption of this proceeding was amended by the Board to reflect the change of name of the original applicant (Berkley, Inc.) which was recorded with the Assignment Branch of the Office at reel 2181, frame 814.

Berkley, Inc. (by change of name to Pure Fishing, Inc.) has filed an application to register the mark BERKLEY CATCH MORE FISH and design, as depicted below,

for the following goods:

Class 7: Battery-operated hook sharpening machines and fishing line strippers;

Class 8: Fishing hand tools, namely, pliers, fishing knives, scissors, hook files, crimpers, line cutters, and manually-operated line spooling machines;

Class 9: Fishing tools, namely, weigh scales;

Class 16: Printed matter in the form of labels and decals;

Class 25: Shirts, caps, hats, jackets, coats and windshirts;

Class 26: Embroidered emblems;

Class 28: Fishing rods; fishing reels; fishing line; artificial fishing lures; artificial fishing baits; fish attractants; fishing tackle, namely, fishing hooks, leaders used for fishing, fishing leader kits, downriggers, swivels, snap swivels, snaps, knotless fasteners, connector sleeves; fishing rod racks; fishing rod holders; tackle boxes; fishing rod cases; sportsperson's fishing bags; and ice fishing strike indicators;

Class 36: Financial sponsorship of fishing, golf and tennis tournaments.[2]

RA Brands, L.L.C. has filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act.[3] In the notice of opposition, opposer alleges use since at least as early as January 1994 by opposer and its predecessor-in-interest, Remington Arms Company, of a design mark for a stylized fish together with a stylized fishing line in connection with opposer's products which include fishing tackle, fishing line, fishing hooks, fishing leaders and flying discs, along with clothing and cloth patches for clothing; ownership of a registration for the mark,[4] in which the design is shown as follows;

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[2] Serial No. 75/671,704, filed March 31, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

[3] Although opposer also makes a general allegation of dilution in the notice of opposition, opposer has failed to pursue this ground. Accordingly, we have given it no consideration.

[4] Registration No. 2,046,114, issued March 18, 1997, for the mark shown above for the following goods:

Class 25: Clothing and apparel, namely, shirts, hats and jackets;
Class 26: Cloth patches for clothing; and
Class 28: Sporting goods, namely, fishing tackle, fishing line, fishing hooks, fishing leaders and flying discs.

The registration contains a description of the mark as "the design of a stylized fish and stylized fishing line artistically arranged to suggest the fish is chasing the line or is hooked by it."

and likelihood of confusion with applicant's use of its mark, which opposer alleges is to be used with identical or closely related goods and which allegedly contains a stylized depiction of a fish that is strikingly similar to that of opposer's mark.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.[5]

The Record

The record consist of the pleadings; the file of the involved application; opposer's testimony deposition, with accompanying exhibits, of Alfred D. Russo, Jr.; applicant's responses to certain of opposer's interrogatories, together with the exhibits provided as part of those responses, made of record by opposer's notice of reliance; and the stipulated testimonial

[5] We note that applicant has attached to its answer exhibits which are alleged to show widespread use of stylized fish images by others as, or in connection with, marks for goods used for fishing. No consideration has been given to these exhibits, inasmuch as exhibits to pleadings are not evidence on behalf of the party to whose pleading the exhibits are attached. See Trademark Rule 2.122 (c). Only those materials introduced by applicant during its testimony period have been taken into consideration.

declaration of applicant's witness Mark V. Sparacino, with accompanying exhibits.

Both parties filed briefs, but an oral hearing was not requested.

Facts

The evidence establishes that in the early to mid 1990s, opposer's predecessor, Remington Arms Company, hired an agency to redesign the packaging for the seven brands of fishing line which were Remington's only products at the time. One of the designs which the agency suggested as a single logo to distinguish all of Remington's fishing products was the stylized fish design which is the subject of this opposition. Mr. Russo testified that at the time the fish design was selected the agency reported, after making a competitive audit of stores and other brands of fishing line, that there was no one in the field using a stylized fish. (Deposition p. 49).

Remington began using the stylized fish design by at least October 1994. Since introduction of the design mark, Remington has not sold any of its STREN line of fishing products without the design mark. Remington does not use the fish design alone, but rather in conjunction with its STREN word mark. (Deposition p. 58). Remington

obtained a registration for its design mark on March 18, 1997 and the registration was later assigned to opposer, an intellectual property holding company, which licensed the mark back to Remington.

Opposer sells its products, and particularly fishing line, in mass merchant outlets such as Wal-Mart and Kmart, in regional chains such as Dick's Sporting Goods, in small retail outlets such as tackle shops, in gas stations and through catalog merchants. The products for the most part are displayed on wall pegs in the stores. Opposer and applicant are direct competitors in the fishing line products market. Opposer and applicant share approximately 80% of the market for these products, with applicant being the market leader at 43-45% and opposer having 35-37% of the market. Applicant markets its products in the same manner as opposer and thus applicant's products are often displayed on pegs in the same stores side-by-side with opposer's products. Opposer's most popular-selling fishing line ranges in cost from $5 to $8 and the comparative products of applicant fall within the same price range.

Opposer's main advertising of its products featuring its fish design mark is by means of magazines and television. The magazines are targeted towards fishermen

or outdoorsmen, either on a national or regional level. The advertisements feature both the STREN word mark and the stylized fish design. Opposer's advertising budget runs several million dollars per year. Opposer also promotes its STREN line of fishing products at trade shows, consumer shows, tournament fishing shows, fishing clinics and the like.

Applicant filed its application on the basis of an intent to use the mark and, although it states in its brief that its mark has been in use since March 1999, applicant has introduced no evidence of actual use of the mark. Opposer, however, has introduced testimony that opposer became aware of applicant's use of its mark approximately 18 to 24 months prior to the taking of the deposition in July 2001.

Discussion

Priority is not an issue here in view of opposer's ownership of its pleaded registration.[6] See King Candy

[6] In order to make a pleaded registration of record, an opposer must either make a status and title copy of the registration of record or introduce testimony as to the status and title of the registration. We note that during the testimony of Mr. Russo with respect to the pleaded registration, he specifically stated that the registration had been transferred from the original registrant, Remington Arms Company, to opposer RA Brands. Thus, current title was established. Mr. Russo gave no direct testimony as to the current status of the registration. In its brief, however, applicant has acknowledged the registration as being of record. Furthermore, the copy introduced as Exhibit 1

Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer's witness Mr. Russo has testified to the use of the stylized fish mark at least by October 1994, a date well prior to applicant's filing of its intent-to-use application on March 31, 1999.

Turning to the issue of likelihood of confusion, we take into consideration all of the *du Pont* factors which are relevant under the present circumstances and for which there is evidence of record. See E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the respective goods are concerned, we find a definite overlap in both the fishing products and the clothing items of the parties. The remaining goods and services of applicant are closely related to opposer's goods. Applicant has in fact acknowledged that its goods and services compete directly with those of opposer. Thus, for purposes of our analysis the goods and services are considered identical in part and otherwise closely related.

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by Mr. Russo was taken from the U.S. Trademark Electronic Search System (TESS) and has the information on its face that the registration was "live" as of the last update of the system, which was July 10, 2001, the date of the deposition. Under these circumstances, we find that opposer has satisfied the requirement with respect to establishing both current title and status of the registration.

Furthermore, there are no restrictions in the goods and/or services as identified in the application and registration as to the channels of trade or the class of purchasers. Because there are no such limitations, it must be presumed that the goods and/or services of both would travel in all the normal channels of trade and be available to all the usual purchasers of goods and/or services of this type. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Mr. Russo has testified that applicant and opposer are the two top competitors in the field and that the goods of both are offered for sale in the same retail outlets and are often displayed side-by-side.

While applicant contends that this side-by-side display affords the prospective purchaser the opportunity for comparison and distinction of both the products and the marks associated therewith, we are not convinced that the purchasers of these types of fishing products, and particularly of fishing line, would take the time or effort to so carefully examine the marks being used by the competitors. Although Mr. Russo has testified as to the availability of different types of fishing line and different equipment according to regional fishing needs,

these fishing products remain relatively inexpensive items which are purchased without any great degree of forethought or consideration, other than perhaps purchasing the right type of fishing line for a particular fisherman's need. While purchasers may have become more sophisticated as to the variety of products available in the field, we do not consider this sophistication sufficient to prevent likelihood of confusion as to the source of the goods if confusingly similar marks are used on the competing products.

Thus, we come to the factor which is highly determinative in our analysis, namely, the similarity or dissimilarity of the respective marks. Opposer's basic argument is that its stylized fish design and the fish design of applicant's mark convey the same overall visual impressions and any small differences in the designs would not be remembered by purchasers. While acknowledging the additional presence of the words BERKLEY CATCH MORE FISH in applicant's mark, opposer argues that purchasers will still think that applicant's goods are sponsored by or are in some way related to opposer in view of the similarity of the two fish designs. Opposer cites the statement made by the predecessor of our present reviewing court (the CCPA) in

its decision in Finn v. Cooper's Inc., 292 F.2d. 555, 130 USPQ 269 (CCPA 1961) that:

> This court has expressly rejected the argument that one may imitate the picture part of a trademark of another, and avoid the likelihood of confusion, mistake, or deception of purchasers by using different
> word trademarks in association with the symbol mark.

130 USPQ at 273.

Applicant, in response, argues that the marks must be considered in their entireties.[7] Applicant contends that opposer's comparison of the mutilated marks, looking only at the fish portion of applicant's mark, is not the proper basis for analysis.[8] In making a detailed comparison of the marks, applicant points not only to differences such as the presence of fishing line in opposer's mark and not in applicant's and the facing of the fish in opposite directions, but also to many smaller differences in the depiction of the fish themselves. In

[7] Applicant, in its arguments, has addressed not only the pleaded fish design of opposer, but also the composite of the fish design and the word STREN, this being the manner in which opposer uses the fish design. Opposer, however, has only pleaded use and registration of the fish design and thus for purposes of this opposition we consider only the fish design. It is well accepted that a party may use more than one mark at the same time and thus we find no reason to consider the fish design other than as a separate mark.

[8] While applicant makes a point of demonstrating that small differences exist between the fish design as actually used by opposer and the registered mark, we find these differences insignificant in our comparison of applicant's and opposer's marks.

addition, applicant notes the prominent appearance of the house mark BERKLEY in its mark, as well as the words CATCH MORE FISH.

Applicant also argues the suggestiveness of the fish design when consideration is given to the fishing products with which the marks are being used. Applicant refers to the declaration of Mark Sparacino which includes as exhibits packaging of eleven third-party fishing products in which a fish, either stylized or more photographic in nature, is depicted. In addition, applicant relies upon the over 400 trademark registrations and applications made of record by opposer's notice of reliance which show marks which consist of, either in whole or part, fish designs for fishing products and services Applicant argues that given the common use of fish designs for fishing products and services, purchasers will look to the words STREN and BERKLEY that are featured, respectively, on opposer's and applicant's products as the indication of source.

When we compare the marks in their entireties, we find the overall commercial impressions of applicant's and opposer's marks to be entirely different. Opposer's mark consists solely of a stylized fish, together with a

stylized fishing line. Applicant's mark is a composite mark featuring not only the house mark BERKLEY, but also the slogan, CATCH MORE FISH. The fish design element of applicant's mark is of minimal significance in the overall impression. Moreover, the fish design itself is clearly not a replica or imitation of opposer's particular design.

Of even more importance is the fact that a fish design in general is highly suggestive when used in connection with fishing products, as demonstrated by the evidence of record. The exhibits attached to the declaration of Mark Sparacino specifically show use by third parties of similar fish designs in connection with fishing products. The third-party registrations, while not evidence of use of the marks or public familiarity therewith, are evidence that fish designs have appealed to others as a trademark element in the field of fishing products and services and that the designs are not particularly distinctive but rather have a suggestive significance in the field. See Bost Bakery, Inc. v. Roland Industries, Inc., 216 USPQ 799, 801, n.6 (TTAB 1982). Contrary to opposer's contention that this third-party evidence is irrelevant because, opposer claims, most of these designs are not remotely similar to

opposer's mark, we find this evidence highly persuasive of what little significance purchasers would attach to the fish design element of applicant's composite mark.

Moreover, the circumstances in the *Finn* case relied upon by opposer are distinctly different from those here. In that case the petitioner's design mark consisted of a representation of a jockey and respondent's mark consisted of the words JERRY FINN and a representation of a hitching post in the form of a jockey. Both marks were being used in connection with clothing. The Board, in Cooper's Inc. v. Finn, 124 USPQ 10 (TTAB 1959), found the jockey figure in respondent's mark to be entirely arbitrary as applied to wearing apparel and to be of such prominence as to create a commercial impression separate and apart from the name JERRY FINN. Thus, the Board determined the figure alone might well be relied upon by purchasers in identifying the source of the goods, and in view of the similarity to petitioner's figure mark, might lead purchasers to assume that respondent's goods originated with, or were in some way associated with, petitioner.

The CCPA upheld the decision of the Board. Finn v. Cooper's Inc, *supra.* The Court emphasized the commercial significance which petitioner's mark had acquired well

before respondent's adoption of a similar symbol "as the dominant part of the registered mark." 130 USPQ at 273. It was under these conditions that the Court applied the principle cited by opposer that one could not "imitate" the symbol or "picture part" of another one's trademark and avoid likelihood of confusion by using a different word mark in conjunction with the symbol.

In this case, however, applicant's fish design is clearly not arbitrary when used in connection with fishing products and related services. Furthermore, applicant's fish design is but a small insignificant portion of its mark as a whole and does not create a commercial impression separate and apart from the composite mark. Thus, there is no reason for purchasers to attribute a common source to the fishing products of applicant and opposer based solely on any similarity of the fish designs.

Despite opposer's arguments that its fish design is well-know and that millions of dollars have been spent advertising and promoting this mark, we cannot place opposer's stylized fish design per se in the category of a well-known mark. As acknowledged by Mr. Russo, the design mark is always used in conjunction with the STREN word mark. Although there may have been large

advertising expenditures and extensive use of the composite mark of which the fish design is a part, there is no evidence of record of separate use or promotion of the fish design. There is no evidence to support any contentions that the fish design alone is well-known or would be recognized by purchasers as what opposer describes as "a unifying icon" for its products. In addition, as pointed out previously, applicant's fish design is not an imitation or close replica of opposer's fish design. All in all, no parallel can be drawn to the circumstances in the *Finn* case.

As a final factor for consideration, opposer raises the question of applicant's intent in adopting its mark, arguing that applicant intended to trade on the goodwill of opposer by selecting its similar fish design. While we would agree that applicant most certainly was aware of opposer's mark, which had been used since 1994 in the same markets and for the same type of fishing products, we can draw no further inferences as to applicant's intent in adopting its mark. Moreover, since we have found that applicant's fish design is neither an imitation of opposer's mark nor a significant element of applicant's mark, we have no basis upon which to conclude that there was bad faith on the part of applicant.

Opposer, having failed to introduce any direct evidence to support its claim, has not established that applicant's adoption of its mark was knowingly done with the intention of trading on the goodwill of opposer's mark.

Accordingly, upon taking all the relevant *du Pont* factors into consideration, we find the balance to fall on the side of no likelihood of confusion. Regardless of the fact that the goods and/or services of the parties are either identical or closely related and the markets are the same, the marked differences in the commercial impressions created by the marks as a whole, taken in conjunction with the highly suggestive nature of a fish design when used with fishing products or related services, clearly tips the scale in applicant's favor.

Decision: The opposition is dismissed.